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10/643,029	08/18/2003	Christopher D. Smith	555255012441	3221
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			ART UNIT	PAPER NUMBER
			2163	
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			11/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/643,029

Applicant(s)

SMITH, CHRISTOPHER D.

Examiner

Patrick A. Darno

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The Finality of the Examiner's Office Action mailed 05/31/2007 has been withdrawn after a Pre-Appeal Conference was held to discuss the rejection of claims 1-17 and 54. New grounds of rejection have been introduced below.
2. Claims 18-53 have been cancelled. Claims 1-3, 6, 8-16, and 54 have been amended. Claims 1-17 and 54 are pending in this office action.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 5-13, and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,980,817 issued to Albert Chow et al. (hereinafter "Chow").

#### **Claim 1:**

Chow discloses a system for triggering a provision event in a service provider using a provisioning request message stored in a computer-readable medium generated by an external system (*Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6*), comprising:

a provisioning system operable to receive the provisioning request message from the external system and transmit information in the provisioning request message to trigger the provisioning event, the provisioning system being a separate entity from the external system and the service provider (*Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6*);

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the provisioning request message including an entity to which the provisioning event pertains, wherein the information includes one or more attributes defined by the external system  
(Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6);

the provisioning system in communication with the external system and the service provider, wherein the service provider is operable to communicate with the entity to cause the provisioning event to occur in response to receiving the provisioning request message from the provisioning system (Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6);

the service provider operable to provide mobile communication service to the entity  
(Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6).

**Claim 2:**

Chow discloses all the elements of claim 1, as noted above, and Chow further discloses wherein the one or more attributes include a name attribute that identifies the entity (Chow: column 13, lines 59-64; Note that the point-of-sale information includes the subscriber name.).

**Claim 5:**

Chow discloses all the elements of claim 1, as noted above, and Chow further discloses wherein the service provider is a mobile data service provider (Chow: column 2, line 47 – column 3, line 3).

**Claim 6:**

Chow discloses all the elements of claim 1, as noted above, and Chow further discloses wherein the provisioning request message further includes provisioning data that identifies a particular entity to which the provisioning event pertains (Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6; See at least the unique electronic serial identification number (MSID)).).

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**Claim 7:**

Chow discloses all the elements of claim 6, as noted above, and Chow further discloses wherein the particular entity is a mobile communication device (*Chow: column 13, line 52 – column 14, line 6 and column 2, lines 43-46; The mobile station (MS) is the mobile communication device.*).

**Claim 8:**

Chow discloses all the elements of claim 6, as noted above, and Chow further discloses wherein the provisioning data includes one or more attributes defined by the external system (*Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6; The attributes defined by the external system include subscriber name, address, credit card number, unique mobile station identification number (MSID), optional personal identification number (PIN) and other verification numbers.*).

**Claim 9:**

Chow discloses all the elements of claim 8, as noted above, and Chow further discloses wherein the one or more attributes include a name attribute that identifies a type of information included within the provisioning data (*Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6; See at least subscriber name.*).

**Claim 10:**

Chow discloses all the elements of claim 9, as noted above, and Chow further discloses wherein the type of information included within the provisioning data includes a personal identification number (PIN) for the entity (*Chow: column 2, lines 47-65 and column 13, line 52 – column 14, line 6; See at least personal identification number (PIN).*).

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**Claim 11:**

Chow discloses all the elements of claim 9, as noted above, and Chow further discloses wherein the type of information included within the provisioning data includes a product identifier for the entity (*Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6; See at least the unique mobile station identification number (MSID).*).

**Claim 12:**

Chow discloses all the elements of claim 9, as noted above, and Chow further discloses wherein the type of information included within the provisioning data includes a billing identifier for the entity (*Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6; See at least the credit card number.*).

**Claim 13:**

Chow discloses all the elements of claim 9, as noted above, and Chow further discloses wherein the type of information included within the provisioning data includes an international mobile subscriber identity identifier (IMSI) for the entity (*Chow: column 14, lines 29-31*).

**Claim 54:**

Claim 54 is rejected under the same reasons set forth in the rejection of claims 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-4, 14, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow in further view of U.S. Patent Application Publication Number 2004/0087300 issued to John Ervin Lewis (hereinafter "Lewis").

**Claim 3:**

Chow discloses all the elements of claim 1, as noted above, but Chow does not explicitly disclose wherein the one or more attributes include a type attribute that identifies an entity type of the entity.

However, Lewis discloses wherein the one or more attributes include a type attribute that identifies an entity type of the entity (*Lewis: paragraph [0121], lines 5-9*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Chow with the teachings of Lewis noted above for the purpose of including a destination device type inside a provisioning request (*Lewis: paragraph [0121], lines 5-9 and paragraph [0127], lines 1-5; First note that the routing information contains a device type. Then note that the routing information is part of the overall provisioning message to be sent.*). The skilled artisan would have been motivated to improve the invention of Chow per the above such that the destination device type would aid in the delivery process of the provisioning request (*Lewis: paragraph [0151], lines 5-8*).

**Claim 4:**

The combination of Chow and Lewis discloses all the elements of claim 3, as noted above, and Lewis further discloses wherein the type attribute identifies a model number of the entity (*Lewis: paragraph [0361], lines 1-4; The mobile identification number is the model number.*).



**Claim 14:**

Chow discloses all the elements of claim 9, as noted above, but Chow does not explicitly disclose wherein the type of information included within the provisioning data includes a mobile subscriber integrated services digital network number (MSISDN) for the entity.

However, Lewis discloses wherein the type of information included within the provisioning data includes a mobile subscriber integrated services digital network number (MSISDN) for the entity (*Lewis: paragraph [0388], lines 1-6 and paragraph [0319]*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Chow with the teachings of Lewis noted above. The skilled artisan would have been motivated to improve the teachings of Chow per the above such that the MSISDN could be used to indicate the mobile directory number for a particular device (*Lewis: paragraph [0388], lines 1-6 and paragraph [0319]*).

**Claim 16:**

Chow discloses all the elements of claim 1, as noted above, and but Chow does not explicitly disclose wherein the provisioning request message includes additional information identifying one or more additional entities to which the provisioning event pertains, and wherein the additional information includes one or more attributes defined by the external system.

However, Lewis discloses wherein the provisioning request message includes additional information identifying one or more additional entities to which the provisioning event pertains, and wherein the additional information includes one or more attributes defined by the external system (*Lewis: paragraphs [0172] and [0173]; These references disclose sending provisioning requests to multiple or additional users. The multiple users are taken from a distribution list and all the users receive the same messages.*



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*Further additional users can be added to any list. Further for each additional user device type, destination address, and all other attributes are included in the message (this is equivalent to the provisioning entity and provisioning data item sections).).*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify teachings of Chow with the teachings of Lewis noted above. The skilled artisan would have been motivated to the teachings of Chow per the above such that a single message would contain routing information for multiple devices (*Lewis: paragraph [0121], lines 1-5*).

**Claim 17:**

The combination of Chow and Lewis discloses all the elements of claim 16, as noted above, and Lewis further discloses wherein a data structure relationship between the provisioning entity section and the one or more additional provisioning entity sections is defined by the external system (*Lewis: paragraphs [0172]-[0173]; The distribution list on the external system creates the data structure relationship between the additional entities.*).

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chow in further view of Lewis and further in view of U.S. Patent Application Publication Number 2004/0058652 issued to Christopher M. McGregor et al. (hereinafter "McGregor").

**Claim 15:**

The combination of Chow and Lewis discloses all the elements of claim 9, as noted above, but the previously mentioned combination does not explicitly disclose wherein the type of information included within the provisioning data includes an integrated circuit card identifier

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(ICCID) for the entity. However, McGregor discloses wherein the provisioning data includes an integrated circuit card identifier (ICCID) for the entity (*McGregor: paragraph [0201]*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of McGregor noted above. The skilled artisan would have been motivated to improve the previously mentioned combination per the above such that the ICCID could be used to identify a particular mobile device (*McGregor: paragraph [0201], at least lines 3-7*).

### ***Response to Arguments***

#### **Examiner Notes:**

Applicant's arguments received 08/21/2007, accompanying a request for a pre-appeal conference, are moot in light of the new grounds of rejection presented by the Examiner.

The Examiner previously rejected claims 1-17 and 54 under 35 U.S.C. 103(a) in a Final Office Action mailed 05/31/2007 based on the following references:

- U.S. Patent Application Publication Number 2003/0065738 issued to Victor Shiang Yang et al. (hereinafter "Yang")
- U.S. Patent Application Publication Number 2004/0087300 issued to John Ervin Lewis (hereinafter "Lewis")
- U.S. Patent Application Publication Number 2004/0058652 issued to Christopher M. McGregor et al. (hereinafter "McGregor")

While the rejections under 35 U.S.C. 103(a) over combinations of references including the Yang reference have been withdrawn, the Examiner is not conceding that the Applicant's

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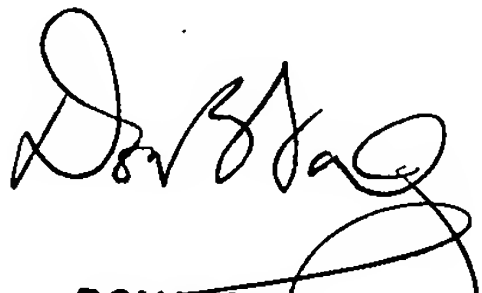
arguments received 08/21/2007 were found to be persuasive. Therefore, the Examiner notes for the record that the relevancy of the Yang reference with respect to the patentability of the instant application may be an issue that is revisited in the future as further consideration is given to both the claimed invention and the prior art during the prosecution of the instant application.

***Contact Information***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick A. Darno whose telephone number is (571) 272-0788. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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